

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

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Mailed: November 17, 2005

Opposition No. 91165024

Michael J. Bullinger

v.

Seven Gables Gutters, Inc.

Before Holtzman, Rogers, and Drost, Administrative Trademark Judges.

By the Board:

On April 27, 2005, Michael J. Bullinger filed a notice of opposition to application Serial Nos. 78313918 and 78313948 of Seven Gables Gutters, Inc.¹ Opposer implies in its opposition that the similarity of the involved marks and goods and services would be likely to cause confusion if the marks were used for these goods and services in the same locations; that although applicant has priority of use, its use has been limited to the state of Georgia; that opposer's

¹ The Board incorrectly instituted this opposition only against application Serial No. 78313918. Application Serial No. 78313948 issued as a registration on September 6, 2005. Office records will be corrected to reflect that this opposition involves both applications, and the registration will be cancelled, and Application Serial No. 78313948 will be restored to pending application status. The Board regrets the error.

first use predates the filing dates of applicant's applications; and that opposer has a pending application for a concurrent use registration listing applicant, its use in Georgia, and the opposed applications as the only exception to opposer's exclusive right to use its mark in the United States (application Serial No. 78315365). Also, while opposer does not claim use throughout the United States, it implies an intent to expand its use throughout the United States except for the state of Georgia.

Geographic limitations to trademark applications and registrations will be considered and determined by the Trademark Trial and Appeal Board only in the context of a concurrent use proceeding. See Trademark Rule 2.133(c). Inasmuch as the notice of opposition is based on allegations that applicant is not entitled to unrestricted registrations in the absence of a geographic restriction, these geographic limitations should be considered in a concurrent use proceeding between these parties.

On July 5, 2005, opposer's concurrent use application Serial No. 78315365 listing Seven Gables Gutters, Inc.'s application Serial Nos. 78313918 and 78313948 as the only exceptions to its exclusive use was published for opposition. The applications involved in a concurrent use proceeding include the concurrent use application and any conflicting unrestricted applications which are identified

in the concurrent use application as being owned by a person listed as an exception to the concurrent applicant's claim of otherwise exclusive use, and which have a filing date prior to the filing date of the concurrent use application. TBMP §1104 (2d ed. rev. 2004). If any application identified in the concurrent use application has been published in the Official Gazette but has not yet cleared the opposition period, the concurrent use proceeding will be instituted, with the owner of that application being included as a common law user, rather than as an applicant. TBMP §1104 (2d ed. rev. 2004). The Board does not determine the right to registration of a party that is included in the proceeding only as a common law concurrent user.

In sum, an opposition is not the appropriate forum for deciding the geographic restrictions implied in the notice of opposition, and so long as the opposition is pending, the applications of Seven Gables Gutters, Inc. cannot be included in the concurrent use proceeding based on Bullinger's concurrent use application.

Accordingly, inasmuch as the issues set forth in the pleadings in this opposition are duplicative of the issues to be determined in the concurrent use proceeding to be instituted between these parties by virtue of the pending

concurrent use application filed by opposer², and inasmuch as dismissal of this opposition will allow the Board to include Seven Gables Gutters, Inc. as an applicant and not as a common law user in the concurrent use proceeding, this opposition is hereby dismissed.

The dismissal of the opposition will not result in the issuance of application Serial Nos. 78313918 and 78313948 as registrations. Application Serial Nos. 78313918 and 78313948 will remain in pending application status until the conclusion of the concurrent use proceeding. In the concurrent use proceeding based on Bullinger's concurrent use application, the Board will determine whether either party is entitled to a concurrent use registration and, if so, the extent of its territory. TBMP §1108 (2d ed. rev. 2004). The Board emphasizes that the dismissal does not involve a decision on the merits of the opposition. Rather, as a procedural matter, this dismissal is based on our finding that the rights of the parties will be more appropriately determined in a concurrent use proceeding. In such proceeding, Seven Gables Gutters, Inc. is free to argue

² Applicant has opposed the concurrent use application of opposer. In a separate order, the Board has dismissed that opposition and instituted a concurrent use proceeding. In that proceeding, applicant is free to argue that opposer is entitled to a more limited territory than that which opposer seeks by its concurrent use application or even that opposer is entitled to nothing. TBMP §1108 (2d ed. rev. 2004).

Opposition No. 91165024

any substantive ground for refusal of Bullinger's application.

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